

REMARKS

Claims 40-41 are now allowed.

Claims 1-24 and 42-43 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected invention. Claims 25-27, 29, 31-41, 44-50 and 53 are currently pending in the application. Reconsideration of the outstanding rejections is requested for the reasons that follow.

Corresponding Japanese Application

Regarding the submission of the Japanese claims, Applicants note that the accepted claims were inadvertently omitted from the previous response. As such, Applicants have attached, as Attachment A, a copy of the accepted claims for the Examiner's review. Applicants request that the Examiner consider the accepted Japanese claims to the extent that they are relevant to the present proceeding.

Objections to the Specification

The Examiner has objected to the specification for the amendments made to remove hyperlinks in the response to the last Office Action. The Examiner has rejected these amendments as new matter. Applicants disagree with the Examiner's argument, but, solely in the interest of expediting prosecution, have amended the specification to remove the recently added text. Further, Applicants have amended the specification as suggested by the Examiner to address the hyperlink issues. As such, this objection has

been obviated and should be withdrawn.

No new matter has been added as a result of these amendments.

Claim Amendments

Without conceding to the Examiner's positions and solely in the interest of expediting prosecution, the following claim amendments have been made. However, Applicants reserve the right to re-introduce any amended/deleted subject matter at any time during the proceedings and/or in one or more divisional applications.

Claims 25 and 26 have been amended to recite "full-length coding sequence of a cDNA transcript" and "wherein the ditag comprises a 5'-terminus sequence and a 3'-terminus sequence of a full-length coding sequence of a gene," as indicated. Claim 44 has been similarly amended, as indicated. Written description support for the above amendments may be found at least at paras. 12 and 14 of the published specification.

Claim 39 has been amended to recite "defining the entire structural region of the corresponding gene on the genome map wherein the region being defined includes exons and introns of the gene." Written description support for this amendment may be found at least at para. 147 of the published specification.

Claim 45 has been amended to recite "restriction site" as indicated.

No new matter has been added as a result of these amendments.

Rejections under 35 U.S.C. § 112, second paragraph

Claims 25-27, 29, 31-39, 44-50 and 53 are rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner argues that the limitation “wherein the ditag comprises sequence information including the 5’ start and 3’ end of a full-length coding region of a gene” in independent claims 25 and 26 does not make clear what is encompassed by this recitation and that the specification does not employ this terminology. Applicants disagree with the Examiner’s arguments. However, solely in the interest of expediting prosecution, independent claims 25 and 26 have been amended to modify this limitation so that the objectionable language has been removed. Written description support is provided as discussed above.

Claim 39 has been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite because of the limitation “defining the structural region including exons and introns of the corresponding gene on the genome.” Specifically, the Examiner argues that it is not clear whether this language merely requires defining the gene or whether it additionally requires defining the exons and introns of the gene. Applicants disagree with the Examiner’s arguments. However, solely in the interest of expediting prosecution, independent claim 39 has been amended to modify this limitation so that the objectionable language has been removed. Written description support is provided as discussed above.

The amendments to the independent claims obviate the rejections for the reasons discussed above and, consequently, they should be withdrawn as to the independent and dependent claims.

Rejections under 35 U.S.C. § 112, first paragraph

The Examiner has rejected claims 25-27, 29, 31-39, 44-50, and 53 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Independent claims 25 and 26 have been rejected for inclusion of the same limitation as discussed above. The Examiner argues that this limitation is new matter and that it is not disclosed in the specification. Independent claim 39 has been rejected for the inclusion of the same limitation as discussed above. The Examiner argues that this limitation is new matter as it is not disclosed in the specification.

Applicants have amended independent claims 25, 26 and 39 as discussed above to overcome the indefiniteness rejections. The present written description rejections are directed to the same claim limitations that were found to be indefinite. As such, the claim amendments modifying these limitations and removing the objectionable language also obviate the present written description rejections. Written description support for these claim amendments is discussed above. Therefore, the written description rejections should also be withdrawn.

Applicants respectfully submit that the claims under examination are in condition for allowance.

Please charge any additional fees to Deposit Account No. 02-2135.

Respectfully submitted,

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